

## **REMARKS**

### **I. Status of the claims**

By this Amendment, Applicants amend claims 1, 4, 6-10, 14, 21 and 23-33. Claims 1-33 are pending in this application.

In the Office Action of June 30, 2004,<sup>1</sup> claims 1-33 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; claims 28-30 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; claims 1-10 and 16-33 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,167,383 to *Henson* ("*Henson*") in view of U.S. Patent No. 5,848,399 to *Burke* ("*Burke*"); and claims 11-15 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Henson* and *Burke* and further in view of U.S. Patent No. 5,774,870 to *Storey* ("*Storey*"). Applicants address the rejections below.

### **II. Rejections of claims 1-33 under 35 U.S.C. § 112**

The Examiner rejected claims 1-33 under 35 U.S.C. § 112, second paragraph, as being indefinite. In rejecting these claims, the Examiner alleged that the claims "are generally narrative and indefinite, failing to conform with current U.S. practice" (OA at 2). The Examiner averred that the claims are "replete with grammatical and idiomatic errors" (OA at 2). In addition, the Examiner rejected claims 4, 8 and 14 as being indefinite, noting that certain features of these claims lack sufficient antecedent basis (OA at 2). Specifically, the Examiner noted that "[t]here is insufficient antecedent basis" for the recitation of "the coupon information" in claims 4 and 8 and "the prize" in claim 14.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

In this paper, Applicants make various amendments to the claims to improve grammar, form, and readability. Applicants also amend claims 4, 8 and 14 to cure the antecedent basis problems noted by the Examiner. Claims 1-33 are fully compliant with 35 U.S.C. § 112, second paragraph, and, as such, the § 112 rejections of these claims should be withdrawn.

### **III. Rejection of claims 28-30 under 35 U.S.C. § 101**

The Examiner alleged that the features of claims 28-30 “can be performed manually without the use of technology” and that these claims recite technology only incidentally (OA at 3). According to the Examiner, claims 28-30 are not within the technological arts and are therefore not permitted under 35 U.S.C. § 101. Applicants disagree.

The Office Action fails to establish that claims 28-30 are non-statutory. The Examiner’s statements that the claims “can be performed manually without the use of technology” and that the claims recite technology incidentally are unsupported and do not by themselves establish that the claims are not permitted under 35 U.S.C. § 101. Moreover, the Examiner’s statement that the claims should be modified to “clearly claim how the technology (i.e. apparatuses) are involved in the method steps” is not supported. For example, the Examiner does not show why the recitation of “sending the selected purchase information to the terminal apparatus” or “sending the use log information to the information distribution apparatus” is not within the technological arts or why either of these features is not clear with respect to how the apparatuses “are involved.” Similarly, the Examiner fails to show why “executing settlement processing of the purchase information using the settlement program” does not involve technology. The mere assertion that certain features could be performed manually or mentally does not support the allegation that the claimed processes are not within the technological arts. In addition, while alleging that “the steps in the claims are [not] actually being performed by . . . apparatuses,” the Examiner provides

no authority supporting such a requirement. Because the allegations in the Office Action are not supported by proper evidence, the rejection of claims 28-30 under 35 U.S.C. § 101 is improper.

Moreover, Applicants point out that whether or not the claims include physical limitations (such as the electronic database, processor, and network mentioned by the Examiner) is not dispositive in determining whether a claimed process is statutory. In fact, the Federal Circuit indicated that arguing that process claims are not patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359 (Fed. Cir. 1999).

The impropriety of the rejection notwithstanding, Applicants have amended claims 28-30 in an effort to advance prosecution. Claims 28-30, as currently amended, are clearly directed to statutory subject matter. The features of these claims are plainly within the technological arts. Further, these claims are not abstract and have practical utility. Indeed, each of claims 28-30 includes recitations that produce “concrete, tangible and useful” results and, therefore, is not abstract and has practical utility. *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998); *AT&T*, 172 F.3d at 1358. For at least the foregoing reasons, the rejection of claims 28-30 under 35 U.S.C. § 101 should be withdrawn.

#### **IV. Rejection of claims 1-10 and 16-33 under 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claims 1-10 and 16-33 under 35 U.S.C. § 103(a) because *prima facie* obviousness has not been established with respect to these claims, as currently presented. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the

knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

As an initial matter, Applicants point out that rejection of claims 1-10 and 16-33 is ambiguous. Applicants cannot discern how, if at all, the Examiner is applying *Burke* to independent claims 1 and 24-33. For example, the Examiner states (OA at 8) that *Henson* does not “explicitly [disclose] . . . a coupon” and relies on *Burke* to cure this deficiency. Independent claims 1 and 24-33, however, do not recite a coupon. Moreover, while making general allegations that the cited references disclose certain subject matter (OA at 8), the Examiner does not specifically address each of the features of Applicants’ claims (e.g., claim 1) such that Applicants have a fair opportunity to reply.

Applicants remind the Examiner that:

[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. M.P.E.P. § 706 (8th ed. 2001).

Applicants also remind the Examiner of the provisions of M.P.E.P. § 706.02(j), which include:

“[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply . . . .”

Should the Examiner continue to dispute the patentability of Applicants’ claims, Applicants request clarification in the next Action (which should not be final) as to *Burke*’s pertinence to the claims, and also that the Examiner address each feature of Applicants’ claims. The ambiguous nature of the rejection notwithstanding, Applicants present the following responsive remarks.

Independent claim 1, as currently presented, recites a combination including:

[a] terminal apparatus including: an operation unit configured to select displayed purchase information, the purchase information selected by the operation unit being sent to the sales apparatus wirelessly through said second communication unit in response to an operation performed by the user when the user purchases the commodity or utilizes the service at the seller location.

*Henson* fails to teach or suggest at least the above subject matter. *Henson* is directed to an on-line user interface that facilitates configuration, pricing, and ordering of a computer system over the Internet (col. 1, lines 19-21). In particular, *Henson* describes an on-line store 10 accessible to customers via the Internet (see Figs. 1, 2). Using *Henson*'s on-line store, customers can select, customize, price, and purchase a product (col. 4, lines 40 – 47). *Henson* also mentions generating “customer-specific variations of a standard online store checkout form” and that “checkout is customizable by store” (col. 11, lines 13-15; col. 11, lines 32-34). *Henson* does not disclose or suggest a terminal apparatus that sends purchase information to a sales apparatus “in response to an operation performed by the user when the user purchases the commodity or utilizes the service at the seller location,” as claimed. To the extent *Henson* discloses sending purchase information at all, it does so only within the context of a user performing an on-line transaction. *Henson*'s on-line store does not send purchase information to a sales apparatus [situated at a seller location] via a wireless communication “when the user purchases the commodity or utilizes the service at the seller location,” as claimed. Instead, it merely facilitates configuration, pricing, and ordering of a computer system over the Internet. *Henson* thus does not teach or suggest at least the “terminal apparatus” recited in claim 1.

*Burke* does not cure *Henson*'s deficiencies. *Burke* is directed to allowing a consumer to “purchase products . . . from home” (col. 2, lines 25-27). *Burke*'s system “generates an image representative of a store shelf which is displayed . . . on the customer's television” (col. 2, lines

27-29). The customer can select a displayed product “to view the product packaging . . . to rotate the package, to view the ingredients of the product, or to purchase the product” (col. 2, lines 32-36). As the Examiner notes, *Burke* mentions that “[m]anufacturers [are] able to display an actual package containing . . . promotional information such as games or coupons” (col. 12, lines 16-20). As the Examiner also notes (OA at 9), *Burke* mentions sending “ordering information to a warehouse where a consumer may pick up an order” (col. 6, lines 50-61). Like *Henson*, *Burke* does not disclose or suggest a terminal apparatus that sends purchase information to a sales apparatus “in response to an operation performed by the user when the user purchases the commodity or utilizes the service at the seller location,” as recited in claim 1. Allowing customers to purchase products from home does not constitute sending purchase information to a sales apparatus [situated at a seller location] via a wireless communication “when the user purchases the commodity or utilizes the service at the seller location,” as claimed. Further, sending “ordering information to a warehouse where a consumer may pick up an order,” does not constitute sending purchase information to a sales apparatus . . . “when the user purchases the commodity or utilizes the service at the seller location,” as claimed.

For at least the foregoing reasons, neither *Henson* nor *Burke*, nor any combination thereof, teaches or suggests at least the “terminal apparatus” recited in claim 1. Accordingly, the applied references, taken alone or in combination, do not teach or suggest each and every element recited in claim 1. As such, *prima facie* obviousness has not been established.

Furthermore, *prima facie* obviousness has not been established at least because the requisite motivation to combine *Henson* and *Burke* is lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including

conclusions of obviousness by the Board, must be supported by “substantial evidence”). Further, the desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show, by substantial evidence, that a skilled artisan considering *Henson* and *Burke*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine those references in a manner resulting in Applicants’ claimed combination. The Examiner does not articulate how *Burke* applies to claim 1, let alone establish that a skilled artisan would have combined *Henson* and *Burke* in a manner resulting in the invention defined by claim 1. For these additional reasons, *prima facie* obviousness has not been established with respect to claim 1.

Each of independent claims 24, 26, 27, 29, 30, 32 and 33 recites features having some relation to the features of claim 1 discussed above. In particular, claims 24 recites:

a sales apparatus, located at a seller site, associated with the commodity sales or service trader and operable to perform wireless communication, the sales apparatus configured to execute a settlement and a proof of purchasing a commodity or utilizing a service according to the purchase information stored in the portable terminal apparatus in response to an operation by the user performed when the user purchases the commodity or utilizes the service at the seller site;

Claim 26 recites:

an operation unit configured to select the purchase information from the displayed purchase information, the selected purchase information being sent to the sales apparatus through said communication unit in response to a user operation performed when the user purchases the commodity or utilizes the service at the seller site;

Claim 27 recites:

a purchase information decision unit configured to decide a classification of purchase information sent by a terminal apparatus associated with a user through said communication unit when the user purchases a commodity or utilizes a service at the seller site;

Claim 29 recites:

sending the selected purchase information to the sales apparatus via a wireless communication in response to an operation performed by the user when the user purchases the commodity or utilizes the service at the seller site;

Claim 30 recites:

receiving, via a wireless communication, purchase information sent by a terminal apparatus associated with a user when the user purchases a commodity or utilizes a service at a seller site;

Claim 32 recites:

sending the selected purchase information to the sales apparatus via a wireless communication in response to an operation performed by the user when the user purchases the commodity or utilizes the service at the store;

And claim 33 recites:

receiving purchase information sent by a terminal apparatus associated with a user via a wireless communication when the user purchases a commodity or utilizes a service at a store where the computer system is located.

Although claims 24, 26, 27, 29, 30, 32 and 33 are of different scope than claim 1, *prima facie* obviousness has not been established with respect to these claims for at least reasons similar to those presented above in connection 1.

Independent claim 25 recites a combination including:

a purchase information selection unit configured to select the purchase information to be distributed to a terminal apparatus associated with the user from said purchase information memory;  
[and]

a communication unit coupled to a wireless connection configured to send the selected purchase information to the terminal apparatus and receive use log information reflecting a result of a use of the selected purchase information from the terminal apparatus.

In rejecting Applicants' claims, the Examiner notes (OA at 8) *Henson*'s description of an implementation of an on-line store, including the disclosure of a configurator, shopping cart, checkout, and database (col. 3, lines 4-11; col. 4, line 56 – col. 5, line 19). The Examiner also notes (OA at 8) *Henson*'s disclosure that the database supplies computer system configuration options to the configurator and supplies payment options to the checkout (col. 3, lines 4-11; col. 3, lines 26-29). In addition, the Examiner notes the disclosure in *Henson* regarding generating "customer-specific variations of a standard online store checkout form" and that "checkout is customizable by store" (col. 11, lines 32 – col. 12, line 9). Neither these disclosures nor any other disclosures in *Henson* teach or suggest the "purchase information selection unit" and "communication unit" recited in claim 25. For example, neither the configurator, shopping cart, checkout, nor database disclosed by *Henson* constitutes a "communication unit . . . configured to send . . . purchase information [selected by a purchase information selection unit] to . . . [a] terminal apparatus [associated with a user] and receive use log information reflecting a result of a use of the selected purchase information from the terminal apparatus," as claimed. Further, the disclosures of supplying configuration and payment options from the database to other on-line store components and customizing checkout do not teach or suggest a "communication unit . . . configured to send the selected purchase information to the terminal apparatus and receive use log information reflecting a result of a use of the selected purchase information from the terminal apparatus," as claimed.

*Burke* does not cure *Henson*'s deficiencies. While *Burke* discloses allowing a consumer to purchase products from home, it does not teach or suggest at least a "communication unit . . .

configured to send the selected purchase information to the terminal apparatus and receive use log information reflecting a result of a use of the selected purchase information from the terminal apparatus,” as claimed. For at least these reasons, *Henson* and *Burke*, taken alone or in combination, fail to teach each and every feature of claim 25. Moreover, for at least reasons similar to those explained above in connection with claim 1, the requisite motivation to combine *Henson* and *Burke* is lacking. A *prima facie* case of obviousness has thus not been established with respect to claim 25.

Similar to claim 25, independent claim 28 recites, *inter alia*:

sending the selected purchase information to the terminal apparatus  
via a wireless communication; [and]

receiving use log information reflecting a result of a use of the  
selected purchase information from the terminal apparatus via the  
wireless communication.

Also similar to claim 25, independent claim 31 recites, *inter alia*:

sending the selected purchase information to the terminal apparatus  
via a wireless communication;

receiving a use log information reflecting a result of a use of the  
selected purchase information from the terminal apparatus via the  
wireless communication.

Although claims 28 and 31 are of different scope than claim 25, *prima facie* obviousness has not been established with respect to these claims for at least reasons similar to those presented above in connection 25.

Claims 2-10 and 16-23 depend from base claim 1. The rejection of these dependent claims should be withdrawn for at least reasons similar to those presented above in connection with claim 1. Moreover, Applicants submit that the Office Action does not show, by substantial evidence, that a skilled artisan considering *Henson* and *Burke*, and not having the benefit of Applicants’ disclosure, would have been motivated to combine these references in a manner

resulting in the invention defined by claims 2-10 and 16-23. The Examiner's conclusory allegations regarding motivation are not properly supported by evidence on the record and do not establish that a skilled artisan would have been motivated to combine the references as alleged.

For example, with regard to claim 2, the Examiner alleges that a skilled artisan would have combined the references "to better motivate the user to purchase the product or service" (OA at 8). Even if a skilled artisan were concerned with motivating consumers, the Examiner does not establish by evidence that a skilled artisan would have modified *Burke's* promotional information contained on a product package viewable by a user via a television set to be a customer-specific "merchandising message" usable in *Henson's* system to achieve that goal. Moreover, as M.P.E.P. § 2143.01 makes clear, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (citations omitted)." In this case, the Office Action does not show that either *Henson* or *Burke* "suggests the desirability" of the alleged combination, and it provides no objective reason from the reference for the combination. That is to say, although the references could be combined "to better motivate the user to purchase the product or service" the Office Action does not show that either of the references "suggests the desirability" of that combination.

Applicants submit that the conclusions in the Office Action pertaining to motivation were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art. For these additional reasons, *prima facie* obviousness has not been established with respect to claims 2-10 and 16-23.

For at least the foregoing reasons, the rejection of claims 1-10 and 16-33 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the rejection and the timely allowance of these pending claims.

**V. Rejection of Claims 11-15 under 35 U.S.C. § 103(a)**

Applicants traverse the rejection of claim 11-15 under 35 U.S.C. § 103(a) because *prima facie* obviousness has not been established with respect to these claims.

Claim 11-15 depend from base claim 1. Neither *Henson* nor *Burke*, nor any combination thereof, teaches or suggests each and every feature of claim 1. These references, taken alone or in combination, therefore fail to teach or suggest each and every feature of dependent claims 11-15. In particular, these references fails to teach or suggest at least the “terminal apparatus” feature recited in claim 1 and required by claims 11-15.

*Storey* does not cure the deficiencies of *Henson* and *Burke*. *Storey* describes an “on-line frequency award program” (Abstract). *Storey* does not teach or suggest at least a “terminal apparatus” that sends purchase information to a sales apparatus situated at a seller location via a wireless communication “in response to an operation performed by the user when the user purchases the commodity or utilizes the service at the seller location,” as claimed. Because *Henson*, *Burke* and *Storey*, taken alone or in combination, fail to teach or suggest at least the claimed “terminal apparatus,” and thus fail to teach each and every claimed feature, *prima facie* obviousness has not been established. The rejection of claim 11-15 under 35 U.S.C. § 103(a) should therefore be withdrawn.

In addition, the required motivation for combining *Henson*, *Burke* and *Storey* is lacking. The Office Action does not show, by substantial evidence, that a skilled artisan considering these references, and not having the benefit of Applicants’ disclosure, would have been motivated to

combine the references in a manner resulting in Applicants' claimed invention. The Examiner's conclusory allegations regarding motivation are not properly supported by evidence on the record and do not establish that a skilled artisan would have been motivated to combine the references as alleged. Applicants submit that the conclusions in the Office Action pertaining to motivation were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art.

For at least the foregoing reasons, the rejection of claims 11-15 under 35 U.S.C. § 103(a) should be withdrawn. Applicants thus request withdrawal of the rejection and the timely allowance of these claims.

**VI. Conclusion**


The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims 1-33.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By:   
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